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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,000	11/29/2000	Erin M. Bourke-Dunphy	MS160277.1	9642

27195 7590 05/16/2005

AMIN & TUROCY, LLP  
24TH FLOOR, NATIONAL CITY CENTER  
1900 EAST NINTH STREET  
CLEVELAND, OH 44114

EXAMINER
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ZHEN, WEI Y

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/726,000

Applicant(s)

BOURKE-DUNPHY ET AL.

Examiner

Wei Y. Zhen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-32 is/are allowed.
- 6) ☒ Claim(s) 1,5-10,19-21 and 33-35 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 11-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. This office action is in response to the appeal brief filed on 1/24/2005.
2. The rejections to claims 2-4, 11-18, 22-32 are hereby withdrawn in view of applicant's arguments.
3. Claims 1, 5-10, 19-21, 33-35 remain rejected.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 35 recites a data packet which is not "physical thing" nor statutory processes. The data packet is non-statutory as not being **tangibly embodied** in a manner so as to be executable to perform any functionalities.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-10, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703) in view of Beelitz et al. (U.S. Patent Number 6,182,275).

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In regard to Claim 9, Smith teaches: (a) providing dependency information relating to at least one service pack (column 2, lines 18-20) and (c) selectively installing the service packs associated with an application component according to setup and dependency information (column 8, lines 18-21). Smith teaches the step of installing the service pack (Column 2, lines 3-4, the service packs are for "installation on a computer system" and hence the service packs are inherently going to be installed on a computer system).

Smith does not teach prompting a user for desired setup information relating to a desired setup for the computer system.

Beelitz, however, does teach generating a setup of a computer system based on user input (Column 22, lines 42-52). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide dependency information relating to at least one service pack and selectively install the service packs associated with an application component according to setup and dependency information, as taught by Smith, where the setup information is acquired by prompting a user for desired setup information relating to a desired setup for the computer system, as taught by Beelitz, since this allows service packs to be installed based on the applications that need them.

In regard to claim 8, Smith teaches service pack installation component is adapted to determine whether application component is installed on the computer system (column 8, lines 18-21).

For specific rejections of Claims 10, 19, see the office action mailed on October 6<sup>th</sup>, 2003.

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In regard to Claims 1, 5-7 which correspond with method claims. The combination of Smith and Beelitz, in particular, teach a user interface (Column 22, lines 37-38), a data store (Figure 1, item 125), and an installation component (Column 28, lines 56-58), thus such system Claims would also have been obvious. Claim 1 corresponds with Claim 9. Claims 5-7 correspond with Claims 14-16 respectively.

6. Claims 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703) in view of Beelitz et al. (U.S. Patent Number 6,182,275) and further in view of Curtis (U.S. Patent Number 6,442,754).

For specific rejections of Claims 20, 21, see the office action mailed on October 6<sup>th</sup> 2003.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 33-35 is rejected under 35 U.S.C. 102(e) as being unpatentable over Smith et al. (U.S. Patent Number 6,477,703).

In regard to Claim 33, Smith teaches generating a service pack based on system parameters and dependency information (Column 2, lines 1-41). Smith also teaches the step of

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installing the service pack (column 2, lines 3-4, since service pack is for installation, and hence the service packs are inherently installed on a computer system.

In regard to Claim 34, Smith teaches: (a) a first component for interrogating a system to identify installed software (Column 2, lines 5-7); (b) a second component for generating a service pack based on system parameters and dependency information (Column 2, lines 14-41). Smith also teaches the step of installing the service pack (Column 2, lines 3-4, the service packs are for installation on a computer system, hence the service packs are inherently installed on a computer system).

In regard to Claim 35, Smith teaches a component for generating a service pack based on system parameters and dependency information (Column 2, lines 14-41). Smith also teaches the step of installing the service pack (Column 2, lines 3-4, the service packs are for installation on a computer system, hence the service packs are inherently installed on a computer system).

#### ***Allowable Subject Matter***

8. Claims 2-4, 11-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 22-32 are allowed.

#### ***Response to Arguments***

9. Applicant's arguments filed on 1/24/2005 with respect to claims 1, 5-10, 19-21, 33-35 have been fully considered but they are not persuasive.

Applicant has argued:

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1) Claim 1 recites the limitation a service pack installation component adapted to selectively install at least one service pack. As described in the subject patent application, a service pack installation component is the structure that corresponds to the function of installing a service pack (as subject to the provisions of 35 U.S.C. 112, 6<sup>th</sup> paragraph). In stark contrast to the manual methods taught by Smith et al, the service pack installation component recited in the claims automates the process of applying setup the dependency information and installing the service packs.

2) Smith et al fails to teach or suggest all of the claim limitations. Independent claims 33-35 recite the limitation a component for structuring and installing a service pack. A component is distinguishable from and has significant advantages over the manual methods taught by Smith et al. because it automates the selective installation process.

Examiner's response:

1) Service pack installation component do not invoke 35 U.S.C. 112, sixth paragraph, because the claim limitations does not use the phrase "means for " and further the claims recites sufficient structure, material or acts for achieving the installation function (see MPEP 2181 [R-2]). For instance, the installation is performed according to the desired setup information and the dependency information. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *automates* the process of applying setup the dependency information and installing the service packs) are not recited in the rejected claim(s). Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *automates* the selective installation process are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei Y. Zhen whose telephone number is (571) 272-3708. The examiner can normally be reached on Monday-Friday, 8 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

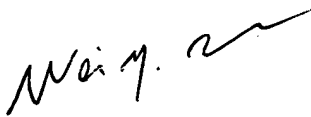


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Wei Zhen  
5/12/2005

  
**WEI Y. ZHEN**  
**PRIMARY EXAMINER**